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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,671	09/27/1999	JIRO INOUE	P/2291-76	1838

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EXAMINER

GESESSE, TILAHUN

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/406,671

Applicant(s)

INOUE, JIRO

Examiner

Tilahun B Gesesse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-11 is/are rejected.
- 7) ☐ Claim(s) 2-5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to applicant's amendment and argument filed April 23, 2004, in which claims 1-5,7-11 are pending.
2. upon applicant's amendment to claim 1, the rejection under 35 USC 112 2nd is withdrawn .

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (5,805,694) in view of Oba et al "oba" (4,980,910).

As to claim 1, Kim discloses a mobile telephone device having a redial function (column 1, lines 38-55 and (figure 1)). Kim discloses a display device (30 of figure 1), an input device for inputting a desired instruction (21 and 22 of figure 1, column 2, lines 40-52). Kim discloses a memory (40) for storing a plurality of redial phone numbers which

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have been dialed (column 2, lines 47-52 and figure 1). Kim discloses a controller for controlling such that a stored phone number related to a selected redial phone number is displayed on the display device (30) to be redialed depending on an instruction input through the input device (column 2, 43-52), the controller is further adapted to retrieve a plurality of dial number from the memory, the phone numbers being related to the stored "registered" phone numbers for sequential dialing until a connection is made (column 2, line 56-column 3, line 65, column 1, line 66-column 2, line 3 and figure 2).

Kim does not expressly teach a ^{1st}second memory, for storing a plurality of registered phone numbers related to a plurality of registered names.

However, Oba teaches a second memory, for storing a plurality of registered phone numbers related to a plurality of registered names (column 9, lines 36-40 and figure 1). Since, Kim teaches a business or party being called has two different telephone numbers (column 1, lines 38-55). Then, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Kim and Oba, in utilizing second memory in addition to the first one, for storing registered phone number and names, as taught by Oba, in order to identify the plurality of phone number of a user by their names related to them, for instance, if the first number is residential number, office number or mobile phone number.

As to claim 7, Kim in view of Oba teach all the limitation as explained above, and further more, Kim teach sequentially selecting the retrieved stored phone numbers until a connection is made (when the first dialed phone number is busy, redial the second one, if not the final digits is dialed ((column 2, line 56-column 3, line 65, column 1, line 66-

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column 2, line 3 and figure 2). It is considered that after the final digit is dialed , connection is made between the calling and called subscriber.

As to claim 8, Kim teaches the stored phone numbers are sequentially selected in predetermined order (the editing technique of Kim, using a volume key 23, until the final digit is dialed by dialing unit 50 (column 3, lines 33-45).

As to claim 9, Kim discloses the controller stores phone numbers related to selected redial phone number on the display device (column 2, lines 40-53 and figure 1).

As to claims 10-11, Kim does not disclose deleting a phone from a memory is full. However, Oba teaches manually deleting key 3w , (column 5, lines 6-10). Since, deleting stored data from memory , is well known in the art , then, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Kim and Oba , in deleting stored data from memory , in order to acquire space in the memory for future use.

Allowable Subject Matter

5. Claims 2-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach a redial phone numbers stored in the first memory device to be redialed on the first selection instruction and in the second memory to be dialed on a second selection instruction.

Response to Arguments

6. Applicant's arguments with respect to claims 1,7-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun B Gesesse whose telephone number is 703-308-5873. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TBG

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May 21, 2004


TILAMUN GESESSE
PATENT EXAMINER